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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,440	12/21/2006	Heinrich Ulrich	20793/0204536-US0	9234
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DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770			EXAMINER LAVARIAS, ARNEL C	
			ART UNIT 2872	PAPER NUMBER
			MAIL DATE 12/01/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/573,440

**Applicant(s)**

ULRICH ET AL.

**Examiner**

Amel C. Lavarias

**Art Unit**

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/27/09, 3/24/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 31-65 is/are pending in the application.
- 4a) Of the above claim(s) 33-44, 46-61 and 63-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31, 32, 45 and 62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/24/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group I (Claims 32, 62) in the reply filed on 10/27/09 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 33-44, 46-61, 63-65 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/27/09.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

4. The originally filed drawings and the replacement drawings were both received on 3/24/06. These drawings are acceptable.

***Specification***

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 31-32, 45, 62 are rejected under 35 U.S.C. 102(b) as being anticipated by Tischer et al. (WO 03/023483 A2), of record.

U.S. Patent No. 6987609, of record, is the issued U.S. patent resulting from the above published document, and may be used as an English translation.

Tischer et al. discloses a microscope (See for example Figures 1-2, 13-14) comprising a microscope objective (See for example 16 in Figures 1-2; 1016 in Figure 13; 1116 in Figure 14), the microscope objective including at least one optical fiber (See for example 1078 in Figure 13; 1178 in Figure 14). Tischer et al. additionally discloses the optical fiber is configured to deliver or convey illumination light for total internal reflection microscopy or TIRF illumination (See for example Page 1, line 19-Page 2, line 16; Page 5, line 30-Page 6, line 17; Page 18, line 5-Page 19, line 10).

8. Claims 31-32, 45, 62 are rejected under 35 U.S.C. 102(b) as being anticipated by Kadogawa (U.S. Patent No. 6195203), of record.

Kadogawa discloses a microscope (See for example Figures 1-2) comprising a microscope objective (See for example 30' in Figure 2), the microscope objective including at least one optical fiber (See for example 64' in Figure 2). It is noted that the limitations of the optical fiber being configured to deliver or convey illumination light for total internal reflection microscopy or TIRF illumination fail to provide any structural limitations for the microscope or microscope objective and is only a statement of intended use of the claimed microscope or microscope objective of Claims 31 and 45. Thus, these limitations have not been given significant patentable weight in this rejection.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 32, 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadogawa in view of Aono et al. (U.S. Patent No. 6819484).

Kadogawa discloses the invention as set forth above in Claims 31 and 45, but does not explicitly disclose that the optical fiber is configured to deliver or convey illumination light for total internal reflection microscopy or TIRF illumination. However, Aono et al. teaches a conventional microscope and microscope objective (See for example Abstract; Figures 1, 3, 5-7, 12) for use in a total internal reflection illumination device for fluorescence. In particular, Aono et al. teaches that such microscope and objective are configured to deliver illumination light to a fluorescent sample under the condition of total internal reflection, thus allowing the sample to be viewed or visually observed (See for example col. 4, line 32-col. 5, line 63). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the optical fiber be configured to deliver or convey illumination light for total internal reflection microscopy or TIRF illumination, as taught by Aono et al., in the microscope and microscope objective of Kadogawa, for the purpose of minimizing or eliminating self-fluorescent light which would deteriorate the viewed image, while also preventing the crossing of the irradiation and return light beams which will minimize generated interference fringes and hence assure an excellent fluorescence observation image (See for example col. 8, lines 50-65 of Aono et al.).

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 571-272-2315. The examiner can normally be reached on M-F 10:00 AM - 6:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on 571-272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arnel C. Lavarias  
Primary Examiner  
Group Art Unit 2872  
11/20/09

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